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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,433

Applicant(s)

STEWART ET AL.

Examiner

Joshua D Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: Application filed on 11/13/2000 and IDS filed on 03/25/2003.
2. Claims 1-11 are pending in this case. Claims 1 and 6-11 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Adamske et al. (US Patent Number 6,615,234, filed on May 11, 1999).

4. **Regarding independent claim 1,**
 - providing the document selected for delivery at the client and uploading the document over the network to the web server;
 - o Adamske et al. discloses a method in which a user selects an electronic version of a document and uploads it to a network (web) server (column 3, lines 46-63 of Adamske et al.);

- receiving configuration information corresponding to a configuration of the document;
 - o Adamske et al. discloses in which the document is uploaded and the format (configuration) of the document is converted to a user-viewable print preview format (column 3, lines 46-63 of Adamske et al.); and
- displaying the document on the interface according to the configuration information;
 - o Adamske et al. discloses a method in which a document's print preview format, which is based on the converted format information, is displayed to the user in an web-browser interface (column 3, lines 46-63 of Adamske et al.).

5. Regarding dependent claim 2,

- receiving a request to order the document;
 - o Adamske et al. discloses a method in which a request is made to order or send out a hard-copy of a document (column 3, lines 18-33 of Adamske et al.).

6. Regarding dependent claims 3 and 4,

- receiving an address for delivery of the ordered document and receiving billing information for payment of the ordered document;
 - o Adamske et al. discloses a method in which an billing/payment information along with the destination (address) to which the document is to be

delivered is received (column 6, line 58-column 7, line 15 of Adamske et al.).

7. Regarding dependent claim 5,

- configuring the document online;
 - Adamske et al. discloses a method in which signatures can be added to the document once it is on the web server, thus changing the format (configuration) of the document (column 8, line 46-column 9, line 2 of Adamske et al.).

8. Regarding independent claim 6,

- uploading a document from a client to a web server;
 - Adamske et al. discloses a method in which a user selects an electronic version of a document and uploads it to a network (web) server (column 3, lines 46-63 of Adamske et al.).
- providing an interface, inputting configuration information corresponding to a configuration of the document, and displaying an image of the document that represents the physical appearance of the document according to the: configuration information;
 - Adamske et al. discloses in which the document is uploaded and the format (configuration) of the document is converted to a user-viewable print preview format (column 3, lines 46-63 of Adamske et al.). Signatures can be added to the document once it is on the web server, thus changing the format (configuration) of the document (column 8, line 46-column 9,

line 2 of Adamske et al.). A document's print preview format, which is based on the converted format information, is displayed to the user in an web-browser interface (column 3, lines 46-63 of Adamske et al.).

9. Regarding independent claim 7,

- an interface to configure and order the document;
 - o Adamske et al. discloses a method in which a document's print preview format, which is based on the converted format information, is displayed to the user in an web-browser interface (column 3, lines 46-63 of Adamske et al.). Signatures can be added to the document once it is on the web server, thus changing the format (configuration) of the document (column 8, line 46-column 9, line 2 of Adamske et al.);
- an upload manager to upload the document from the client and transferring it to the web server;
 - o Adamske et al. discloses a method in which a user selects an electronic version of a document and uploads it to a network (web) server using a web-browser interface (upload manager) (column 3, lines 46-63 of Adamske et al.); and
- a facility to deliver the configured document to a specified delivery address;
 - o Adamske et al. discloses a method in which a document is printed at a print delivery destination at which point it can be delivered to a recipient via a courier (column 3, line 64-column 4, line 29 of Adamske et al.).

10. Regarding independent claim 8,

- an application enabling a user to select the, document for delivery;
 - Adamske et al. discloses a method in which a user selects an electronic version of a document and uploads it to a network (web) server (column 3, lines 46-63 of Adamske et al.);
- an upload manager launching the interface to view the document as a result of selecting the document for delivery;
 - Adamske et al. discloses a method in which a document's print preview format, which is based on the converted format information, is displayed to the user in an web-browser interface (column 3, lines 46-63 of Adamske et al.).

11. **Regarding independent claims 9-11**, the claims incorporate substantially similar subject matter a claim 8. Thus, claims 9-11 are rejected along the same rationale as claim 8.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 5,559,933, issued to Boswell (IDS);

US Patent Number 5,873,073, issued to Bresnan et al. (IDS);

US Patent Number 5,963,216, issued to Chiarabini et al. (IDS); and

US Patent Application Publication Number 2001/0055492, filed by Wood et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

jdc
January 7, 2004



STEPHEN S. HOHN
PRIMARY EXAMINER